REMARKS

This paper is filed in response to the Examiner's Action issued on January 31, 2007. Claims 1-38 are pending in the application. Claims 1-32 and 36-38 are rejected, while claims 33-35 are objected.

Paragraph 6 of the specification is objected to because of reference to an incorrect patent number. The specification has been corrected. Applicants request withdrawal of this objection.

Claims 8, 29 and 30 are rejected under 35 U.S.C. §112 because of insufficient antecedent basis for a limitation in the respective claims. The claims have been amended to provide the requisite antecedent basis. Applicants request withdrawal of this rejection.

Claims 1, 9-10, 18-19, and 29-30 have been amended to more clearly define the subject matter claimed by the invention. Applicants submit that no new matter has been added by these amendments.

Claims 1, 3-6, 10, 12-15, 19-28, 30, 32 and 36-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Mathis et al. Claims 2, 11 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Mathis et al. and further in view of Drieman et al. Claims 7-9, 16-18 and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Mathis et al. and further in view of Richardson, Jr. Claims 33-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants traverse the rejection of the claims.

Ground 1 Claims 1, 3-6, 10, 12-15, 19-28, 30, 32 and 36-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim (6,336,794) in view of Mathis et al. (6,011,336). Applicants traverse this ground of rejection.

Rejections under 35 U.S.C.§103(a)

A. MPEP 2142, under ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS, provides: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure [citations omitted]. *See* MPEP para 2143-2143.03 for decisions pertinent to each of these criteria."

First requirement--there must be an objective basis for combining the teachings of the references

The first of the requirements of MPEP 2142 is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings." The present rejection is a §103 combination rejection. To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2142, 2143 and 2143.01. *See also*, for example, In re Fine, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed. Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-313 (Fed. Cir., 1983), and Ex parte Levengood, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

> "The PTO has the burden under section 103 to establish a prima facie case of obviousness [citation omitted]. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

> "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

> "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."
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> "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."
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> "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App.& Inter. 1993)."

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in

light of the present disclosure. In this case, there are multiple asserted combinations of teachings.

In this rejection, there are two references that are combined to make the invention "obvious." Certainly that is permissible, but there must be a showing that the two references, taken together, meet the "objective basis" requirement of MPEP 2143.01. Otherwise, it is too easy to use unrelated references to form a hindsight reconstruction of a claim.

The combination of Kim and Mathis. Kim deals with an assembly comprising a rotary compressor including an accumulator in which the center of gravity of the rotary compressor is correspondingly disposed at the geometric center of the supporting holes on a supporting plate. The purpose is to reduce the vibration and noise of the compressor by uniformly distributing the load exerted by the compressor on each of the vibration isolating members. Mathis teaches a vibration-isolating mounting system for motors that includes as one of several unique features a semi-circular saddle surface formed at a radius that corresponds to a motor housing. Kim teaches the use of a flat palate with supporting holes located at apices, with vibration dampers assembled into the supporting holes. To achieve the improved vibration suppression, the geometric center of the *supporting holes* must correspond to the center of gravity of a rotary compressor having an accumulator, while Mathis teaches a different vibration isolating system for spa components that happens to include as one of its features, a semi-circular saddle surface formed in the motor mount, but which relies on a complex arrangement of a vibration-isolating pad underlying the motor mount along with clamps and bumpers to assist in isolating the pad. The explanation of this rejection does not discuss any rationale for combining the teachings of these unrelated systems for controlling vibration in different components.

Applicants see no way of combining the references to obtain applicants' invention. Kim is directed to solving a problem with rotary compressors having accumulators. Rotary compressors operate fundamentally differently than the now-claimed reciprocating compressors. Thus, there is substantial reason for the center of gravity of the rotary compressor to coincide with the geometric center of the support holes. In fact, in Figure 2 of Kim, the center of gravity of the rotary compressor having the accumulator is depicted directly over the geometric center of the support holes of the plate, although the housing of the rotary compressor is offset from this geometric center. The fact that the support plate is flat allows rotary compressors having different

center of gravities (due to slightly different sizes, components or different size accumulators) to be mounted thereon by simply shifting the position on the plate to correspond to the center of gravity of the compressor and accumulator, inasmuch as the geometric center of the support holes is fixed. Assuming arguendo that it is proper (which applicants dispute) only to adopt the depression/concavity feature of Mathis et al., this concavity as taught in Mathis has a low point at its center, which also happens to be the geometric center of Figure 2. The incorporation of the semi-circular saddle surface of Mathis, corresponding to a motor housing, into Kim would result in the compressor housing of Kim being located in the geometric center of the plate. This is not applicants' invention, which *claims* that the *depression* be offset in a direction of one of the perimeter walls, and the combination does not yield applicants' invention.

If the rejection is maintained, Applicants asks that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references to obtain applicants' invention, and for adopting only the helpful teachings of each reference while disregarding the unhelpful teachings of each reference. Thus, as it stands now, the invention as a whole is not prima facie obvious over the combined teachings of the prior art.

Second requirement--there must be an expectation of success

The second of the requirements of MPEP 2142 is an expectation of success. There is no expectation of success. This requirement has not been addressed in the explanation of the rejection, and in any event more than Examiner's argument is required here.

As stated in MPEP 2142, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. [citations omitted]."

Applicants submit that there is no reasonable expectation of success since the concavity, described at col. 2, lines 47-50 of Mathis as a semi-cylindrical saddle surface, corresponds to a motor housing and the center of the saddle surface would be at the geometric center of the supporting holes. It is also clear that the assembly of the rotary compressor having an accumulator of Kim into the concavity of Mathis would result in the motor housing being centered in the saddle surface. However, referring to Fig. 2 of Kim, the center of gravity of the motor housing and accumulator in this arrangement is

offset from the center of the motor housing. Thus, the center of gravity of the motor housing would be offset from the geometric center of the supporting holes, and the vibration damping taught by Kim would be defeated. Thus, there would be no expectation of success.

Third requirement--the prior art must teach the claim limitations

The third of the requirements is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." In this regard, the following principle of law applies to all §103 rejections. MPEP 2143.03 provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." [emphasis added] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand. In this case, the applied prior art references clearly do not arguably teach some limitations of the claims.

In the following discussion, Applicants will assume arguendo that Kim and Mathis et al. are properly applied, which in fact they are not, for the reasons stated earlier. Also, the dependent claims incorporate all of the limitations of the independent claims, and add elements further limiting their scope; therefore Applicants incorporate the discussion of the parent claim into the discussion of each dependent claim that depends from the parent claim.

Claim 1 (and claims 3, 4, and 6) as amended is directed to a reciprocating compressor and recites in part:

> ...an offset mounting foot having a main body with a top surface, an opposed bottom surface and perimeter surface side walls extending between the top and bottom surfaces, the top surface including a depression that is offset in a direction of one of the perimeter surface side walls, the depression conforming to at least a portion of the compressor lower housing so as to receive the compressor on installation onto the floor of the cabinet...

As discussed above, the combination set forth by the Examiner does not teach or suggest a cavity or depression positioned as claimed above. At best, it

teaches a cavity or depression having a center located at the geometric center of the support holes.

And, claim 1 further requires

> ...the compressor centered in the top surface depression,...

A compressor centered in the top surface depression of the present invention would also be offset in the direction of one of the perimeter surface side walls. This limitation also would not be met if the combination set forth in the Examiner's action were viable, as discussed above.

In addition to the limitations of claim 1, claim 5 further recites in part:

> ....a plurality of appendages extending from the main body, each appendage including an aperture ...

Neither Kim nor Mathis et al. disclose a plurality of appendages extending from the main body, each appendage having an aperture. Kim discloses apertures at apices (corners), while Mathis et al discloses a pair of apertures, one located along each edge (see Figure 2).

Claim 10 (and claims 12-15) recites in part:

> ... an offset mounting foot having a main body with a top surface, an opposed bottom surface and perimeter surface side walls extending between the top and bottom surfaces, the bottom surface being installed onto the floor of the cabinet, the offset mounting foot further including a main body, a plurality of appendages extending from the main body with perimeter surface segments forming a portion of the perimeter surface sidewalls extending between the appendages, the top surface including a depression that is offset in a direction of one of the perimeter surface segments, the depression conforming to at least a portion of the compressor lower housing section so as to receive the compressor on installation onto the floor of the cabinet,...

As discussed above, the combination set forth by the Examiner does not teach or suggest a cavity or depression positioned as claimed above. At best, it teaches a cavity or depression having a center located at the geometric center of the support holes. In addition, neither Kim nor Mathis et al. disclose a plurality of appendages extending from the main body, each appendage having an aperture. Kim discloses apertures at apices (corners), while Mathis et al discloses a pair of apertures, one located along each edge (see Figure 2).

Claim 19 (and claims 19-28, 30, 32 and 36-38) recites in part:

> ...the top surface having a profile generally in the form of a concavity, a low point of the concavity, where the top surface achieves its closest approach to the bottom surface, being offset in a direction of one of the sidewalls forming the perimeter...

As discussed above, the combination set forth by the Examiner does not teach or suggest a cavity or depression positioned as claimed above. At best, it teaches a concavity having a center located at the geometric center of the support holes.

Applicants submit that the Ground 1 rejection fails under each of criteria required under MPEP 2142 for establishing a prima facie case of obviousness and request withdrawal of this ground of rejection.

B. MPEP Section 2141.02 (VI) under PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMED INVENTION, provides in part "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ." The Kim reference, considered in its entirety, teaches away from the claimed invention. The claimed invention requires a mounting foot that mounts the compressor in a direction offset from one of the perimeter walls. The stated purpose of the offset mounting, as set forth in the specification, is to provide, upon installation of a reciprocating compressor additional room in the cabinet to more effectively utilize the space in the cabinet while also providing vibration damping. Kim requires a mounting plate that centers a rotary compressor so that the center of gravity of the compressor corresponds to the geometric center of the mounting holes of the plate in order to achieve improved vibration damping. The Kim reference teaches that the location of the center of gravity of the compressor over this geometric center is the invention; the fact that the compressor may be mounted offset as shown in the Figure cited by the Examiner is a happenstance resulting from the fact that the rotary compressor includes an attached external accumulator that alters the center of gravity of the compressor. A unit having a center of gravity corresponding to the centerline of the compressor, according to the teachings of Kim, would mandate the compressor be

centered at the geometric center of the plate. This is contrary to the claimed invention, which is not concerned with the location of the center of gravity of the compressor, but rather claims an offset mounting foot that results in a compressor that is offset in the cabinet to maximize the working space. The teaching of Kim that requires locating the compressor center of gravity over the geometric center of mounting holes is inconsistent with mounting the compressor to maximize cabinet space, particularly for a reciprocating compressor such as disclosed in which the accumulator is internal so that its center of gravity is located substantially along its vertical axis. As the Court stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc., supra* "when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher", this Ground 1 rejection also fails for this reason. Because Kim et al. teaches away from the claimed invention, Applicants also request withdrawal of the rejection on this basis.

Ground 2 Claims 2, 11 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim (6,336,794) in view of Mathis et al. (6,011,336) and further in view of Driemen et al. 6,092,284. Applicants traverse this ground of rejection. Kim in view of Mathis et al. is discussed above and that rejection is further fully incorporated into this response. Driemen et al. teaches the use of welding projections 68 to facilitate welding of a mounting bracket 60 to a compressor. The mounting bracket is used to facilitate the attachment of an accumulator to the compressor (see Abstract; col. 6, lines 12-15).

The requirements of MPEP 2142 are set forth above under Ground 1 and apply equally to Ground 2. Applicants will not repeat these requirements for the Examiner

First requirement--there must be an objective basis for combining the teachings of the references

The combination of Kim and Mathis et al. was discussed above with regard to independent claims 1, 10 and 19 and applies equally to claims 2, 11 and 29, dependent directly or indirectly on these independent claims. Here again, there is also set forth no

objective basis for combining the teachings of the Driemen et al with Kim and Mathis et al. in the manner used by this rejection, and selecting the helpful portions from each reference, while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. In this case, there are multiple asserted combinations of teachings.

In this rejection, there are three references that are combined to make the invention "obvious." Certainly that is permissible, but there must be a showing that the three references, taken together, meet the "objective basis" requirement of MPEP 2143.01. Otherwise, it is too easy to use unrelated references to form a hindsight reconstruction of a claim.

The combination of Kim and Mathis et al. was discussed above. Driemen et al. further adds welding bosses 68 to a mounting bracket 60 to facilitate attachment of an accumulator assembly 20 to the bracket 60. While Kim discusses an accumulator attached to a rotary compressor by a bracket, Kim does not otherwise discuss the attachment, that not being an important aspect of the invention of Kim. Mathis et al. is not even directed to compressors, so it includes no discussion of attachments of accumulators. This rejection essentially catalogues a listing of features that are disclosed in other patents. The explanation of this rejection does not discuss any rationale or motivation for combining the teachings of these unrelated systems which teach providing projections on a bracket for welding an accumulator to the bracket to achieve the present invention for providing bosses in an offset mounting foot to facilitate welding of the compressor to it.

If the rejection is maintained, Applicants ask that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references to obtain applicants' invention, and for adopting only the helpful teachings of each reference while disregarding the unhelpful teachings of each reference. Thus, as it stands now, the invention as a whole is not prima facie obvious over the combined teachings of the cited prior art.

Second requirement--there must be an expectation of success

The second of the requirements of MPEP 2142 is an expectation of success. There is no expectation of success. Again, this requirement has not been addressed in

the explanation of the rejection, and in any event more than Examiner's argument is required here.

As stated in MPEP 2142, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. [citations omitted]."

Applicants submit that there is no reasonable expectation of success in the prior art since the projections of Driemen et al. are not directed to the same structure (accumulator) or attachment as taught by applicants. In fact, applicants do not discuss or claim a structure such as an external accumulator.

Third requirement--the prior art must teach the claim limitations

The third of the requirements is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

To the extent that claims 2, 11 and 29 are dependent on independent claims 1, 9 and 19, the dependent claims include all of the limitations of the independent claims. The applicability of the discussion of Kim and Mathis et al. as discussed above applies equally to these dependent claims. Assuming arguendo that Drieman et al. is properly combined with Kim and Mathis et al. (which combination applicants submit is in fact improper as discussed above), Drieman et al. adds a bracket that includes welding projections for attachment of an accumulator.

Claims 2 and 11 recites in part:

> ...wherein the offset mounting foot includes a plurality of bosses and the means for assembling the compressor to the offset mounting foot to form an assembly includes welding the compressor housing to the bosses...

Claim 29 is similar.

As discussed above, the combination set forth in the rejection does not teach or suggest the elements of this claim, that is a base for a reciprocating compressor in the form of an offset mounting foot that includes bosses for weld attachment of the

compressor. Even if the combination were proper, it would not yield the elements and their arrangement as claimed.

Applicants submit that the Ground 2 rejection fails under each of criteria required under MPEP 2142 for establishing a prima facie case of obviousness and request withdrawal of this ground of rejection.

Ground 3 Claims 7-9, 16-18 and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kim (6,336,794) in view of Mathis et al. (6,011,336) and further in view of Richardson, Jr. (4,946,351). Applicants traverse this ground of rejection. Kim in view of Mathis et al. is discussed above and that rejection is further fully incorporated into this response. Richardson, Jr. teaches the use of welding projections 68 to facilitate welding of a mounting bracket 60 to a compressor. The mounting bracket is used to facilitate the attachment of an accumulator to the compressor (see Abstract; col. 6, lines 12-15).

With regard to claims 7-8 and 16-17, applicants do not dispute that Richardson Jr. discloses the use of grommets or that EPDM is a known material. However, applicants note that claims 7-8 and 16-17 are indirectly dependent on independent claims 1 and 10 respectively, incorporating all of the limitations of these independent claims as well as the intervening dependent claims. The patentability of independent claims 1 and 10 as well as the intervening claims are discussed above and incorporated by reference here, but will not be repeated. Claims 7-8 and 16-17 include additional elements, adding further limitations to these claims. For example, the grommets of claim 7 are inserted into apertures located in appendages (claim 5). These elements are not disclosed in the prior art, as Richardson Jr. discloses the location of the apertures between the inner diameter and outer diameter of a circular shaped mounting boot.

Claims 9 and 18 have been amended for clarification. Claims 9 and 18 now refer to bore 38 (see Figure 1) that extends through concavity. This bore previously was referred to an aperture, which may have been a source of confusion in claims 9 and 18. However, claim 31 does not require a similar amendment, as reference was always

made to a "bore". It should not be clear to the Examiner that applicants' bore 38, Figure 1, is a completely different feature from the mounting holes 92 discussed in Richardson.

Based on the above, applicants request withdrawal of the grounds of rejection set forth under Ground 3.

CONCLUSION

Applicants respectfully requests entry of the above amendment. For at least the reasons set forth above, Applicant respectfully requests reconsideration of the Application and withdrawal of all outstanding objections and rejections. Applicant respectfully submits that the claims are not anticipated by, nor rendered obvious in view of the cited art either alone or in combination and thus, are in condition for allowance. Thus, Applicant requests allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant's undersigned representative.

This Response has been filed within three (3) months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicant is mistaken in these calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059

The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,

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